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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/977,374	11/24/97	BAKKER	W GLP006/JTN

JAMES T NENNIGER  
PIASETZKI & PIASETZKI  
120 ADELAIDE STREET WEST  
SUITE 2308  
TORONTO ON M4H 1T1  
CANADA

IM71/0804

EXAMINER
WATKINS III, W

ART UNIT	PAPER NUMBER
1772	

AIR MAIL

DATE MAILED: 08/04/98

**Please find below and/or attached an Office communication concerning this application or  
proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/977,374

Applicant(s)

Baker Steel

Examiner

W. Watkins

Group Art Unit

1772

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on Spec & Prelim Filed 11-24-97.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-9, 21-23 & 26, 36-42 is/are pending in the application.
- Of the above claim(s) 1-9, 21-23, & 26 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 36-42 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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#### DETAILED ACTION

1. Applicant's election without traverse of Group II, claims 36-42 in Paper No. 6, filed July 6, 1998 is acknowledged.

2. Claim 37 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The first means in claim 36 recites that it absorbs radiant energy as required by claim 37. There is no further limitation in claim 37. Also there is no antecedent basis in claim 37 for said "thin film", "thin" being removed by amendment in the parent case due to a 112 rejection.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 36-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heilman et al. (Australia 27,337) in view of Anderson et al. (U.S. 5,113,479).

Heilman et al. teach a film which extends over the rim of a container and is heat shrunk onto the container by applying energy which may be in the form of infrared radiation to the edge first while the top is shielded, then to the top as an option to further tighten the film (page 10). Anderson et al. teach the use of coloring on a edge to better absorb infrared radiation to raise the temperature to heat seal the edge of the film. The instant invention claims a printed area on the edge rim of a film lid to better absorb radiation in order to heat shrink the film. It would have been obvious to one of ordinary skill in the art to color the edge of the film of Heilman in order to be better able to apply infrared energy in a selective manner to the rim as opposed to the top of the lid because of the teachings of Anderson et al. to enhance infrared energy absorption in a limited area by the use of coloration.

5. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA

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1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 36-42 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 15, 16 and 19 of copending Application No. 08/699,332. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ only in the language used to describe the same structure.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. This is a continuation of applicant's earlier Application No. 08/638,160. All claims are drawn to the same invention claimed in the earlier application and could have been finally

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rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is (703) 308-2420.

The examiner's normal work hours are Monday through Friday 9:30 A.M. through 6:00 P.M. The examiner's supervisor is Ellis Robinson whose telephone number is (703) 308-2364. Any general

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inquiry can be directed to the Group receptionist whose telephone number is (703) 308-0651.

The Fax number for official **after final** papers is 703-305-3599. The Fax number for official **non-final** papers is 703-305-5408. The Fax number for **informal** non-official communications directed to the examiner is 703-305-5436.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ellis.robinson@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.



WW/ww  
August 1, 1998

**WILLIAM P. WATKINS III**  
**PRIMARY EXAMINER**